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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,629	01/16/2004	Toshiharu Katagiri	1018.1201101	1206
28075	7590	10/05/2005	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC			AU, SCOTT D	
1221 NICOLLET AVENUE			ART UNIT	
SUITE 800			PAPER NUMBER	
MINNEAPOLIS, MN 55403-2420			2635	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/759,629

Applicant(s)

KATAGIRI ET AL.

Examiner

Scott Au

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-9,14-17,20,21,23 and 24 is/are rejected.
- 7) ☒ Claim(s) 2,4,5,10-13,18,19,22 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 011604.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The application of Katagiri et al for a "Remote control key for preventing theft of transponder and method for manufacturing the same" filed January 16, 2004 has been examined.

Claims 1-25 are pending.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,6-7,9,15-16,20,23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onuma (US# 5,945,906) in view of Kleefeldt et al. (US# 5,561,420).

Referring to claims 1 and 15, Onuma discloses a method for manufacturing and device of a remote control key (1) (i.e. key) comprising: a transmitter of (1c) (i.e. keyless remote controller) for transmitting a signal to remotely control locking and unlocking of a door; a transponder of (1b) (i.e. transponder) for transmitting a predetermined ID code; a housing for retaining the transmitter and the transponder of (1b) (i.e. transponder); a pad (i.e. a pad formed the 1a button) formed on an outer surface of the housing to operate the transmitter of (1c) (i.e. keyless remote controller);

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and a seal (i.e. within the housing of the key 1) for sealing the transponder of (1b) (i.e. transponder) that is retained in the housing.

However, Onuma did not explicitly disclose wherein the seal and the pad are formed from the same material.

In the same field of endeavor of key element, Kleefeldt et al. suggest a transmitter (4) and a transponder (9) are formed from the same plastic material (col. 5 lines 4-26).

One skilled in the art recognizes having a transmitter (4) and a transponder (9) are formed from the same plastic material of Kleefeldt et al. is desirable in the key element of Onuma because Onuma suggests both transmitter of (1c) and transponder of (1b) is within the housing head of key 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made having a transmitter and a transponder are formed from the same plastic material of Kleefeldt et al. in the key head element of Onuma with the motivation for doing so would allow the convenience of making the product.

Referring to claims 3 and 16, Onuma in view of Kleefeldt disclose the method and the remote control key of claims 1 and 15, Onuma suggests the transmitter and transponder are operated with the same button function 1a, therefore the pad and the seal are formed integrally with each other (i.e. see Figures 1-2).

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Referring to claims 6 and 23, Onuma in view of Kleefeldt disclose the method and the remote control key of claims 1 and 15, Onuma suggests the transmitter and transponder are operated with the same button function 1a, therefore the pad and the seal are connected to each other.

Referring to claims 7 and 20, Onuma in view of Kleefeldt disclose the method and the remote control key of claims 1 and 17, it is obvious that the button 1a is a seal and pad used to control the functions 1b and 1c are flexible material.

Referring to claims 9 and 24, Onuma in view of Kleefeldt disclose the method and the remote control key of claims 1 and 15, Onuma suggests wherein the housing includes a first retainer for retaining the transmitter and a second retainer for retaining the transponder (i.e. see Figure 2).

Claims 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onuma (US# 5,945,906) in view of Kleefeldt et al. (US# 5,561,420) as applied to claim 7 and further in view of Behlke (US# 5,604,493).

Referring to claims 8 and 21, Onuma in view of Kleefeldt et al. disclose the method and the remote control key of claims 7 and 20. However, Onuma in view of Kleefeldt et al. did not explicitly disclose wherein the flexible material is an elastomeric material.

In the same field of endeavor of electronic control device, Behlke suggests the electronic device is made of the flexible material, an elastomeric material (col. 5 lines 14-18).

One skilled in the art recognizes having the electronic device is made of the flexible material, an elastomeric material of Behlke is desirable in the electronic key head housing of Onuma in view of Kleefeldt et al. because Kleefeldt et al. suggest housing of the remote device 3 is made of plastic (col. 5 lines 10-15) and Behlke suggest the electronic key housing is made of elastomeric material in order to provide the softer feel.

Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onuma (US# 5,945,906) in view of Kleefeldt et al. (US# 5,561,420) as applied to claim 7 and further in view of Miller (US# 5,331,325).

Referring to claims 14 and 17, Onuma in view of Kleefeldt et al. disclose the method and the remote control key of claims 1 and 15. However, Onuma in view of Kleefeldt et al. did not explicitly disclose further comprising a cover attached to the housing to cover the transmitter and the transponder, and a screw for fastening the cover to the housing.

In the same field of endeavor of electronic key device, Miller discloses a cover attached to the housing to cover the transmitter and the transponder, and a screw for fastening the cover to the housing (col. 4 lines 26-44).

One skilled in the art recognizes having a cover attached to the housing to cover the transmitter and the transponder, and a screw for fastening the cover to the housing of Miller is desirable in the electronic key of Onuma in view of Kleefeldt et al. because Kleefeldt et al. suggest electronic devices within the housing of key head (i.e. see Figure 2) and Miller suggest a cover attached to the housing to cover the transmitter and the transponder, and a screw for fastening the cover to the housing (col. 4 lines 26-44) in order to secure the electronic devices located inside.

### ***Claim Objections***

Claims 2,4-5,10-13,18-19, 22 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to claim 2, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein the transponder is sealed so that removal of the transponder from the seal partially exfoliates the seal and leaves a removal mark on the outer surface of the housing.

Referring to claims 4 and 22, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein the seal is partially exposed from the outer surface of the housing.

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Referring to claim 5, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein at least part of the pad is overlapped with the seal.

Referring to claim 10, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein the housing includes a receptacle connected with the first retainer and partially connected with the second retainer.

Referring to claim 11, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein the housing includes a partition for defining a retainer which retains the transponder, and a receptacle in which the pad is formed, and wherein the receptacle is connected with the retainer.

Referring to claim 12, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that a cover attached to the housing to cover the transmitter and the transponder, wherein the seal is exposed from joining surfaces of the housing and the cover.

Referring to claim 13 and 18, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that a cover



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attached to the housing to cover the transmitter and the transponder, wherein the seal covers the entire transponder so that the transponder is not visible from the exterior when the cover is removed from the housing.

Referring to claim 19, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein said sealing the transponder includes sealing the transponder with a seal that is exposed from an outer surface of the housing or the cover.

Referring to claim 25, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that wherein the housing includes a receptacle connected to the first retainer and partially connected with the second retainer, said forming the pad includes filling material for forming the pad in the receptacle, and said sealing the transponder includes sealing the transponder with the material filled in the receptacle.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ostermann et al. (US# 5,798,576) suggest a portable unit is used to operate a vehicle security system.

Wallace (US# 6,191,703) suggests a portable unit is used to operate a vehicle security system.

Lindner et al. (US# 6,469,616) suggest a portable unit is used to operate the anti-theft system.

Yoshizawa (US# 6,414,586) suggest a keyless entry system.

Hiebl (US# 6,496,100) suggests a keyless entry system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Au whose telephone number is (571) 272-3063. The examiner can normally be reached on Mon-Fri, 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached at (571) 272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are (571)-272-1817.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Scott Au

MICHAEL HORABIK  
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